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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,498	03/24/2004	Toshiaki Shibuc	KON-1615C (Div)	5708

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EXAMINER	
MCPHERSON, JOHN A	

ART UNIT	PAPER NUMBER
1756	

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/808,498	SHIBUE ET AL.	
	Examiner	Art Unit	
	John A. McPherson	1756	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 March 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *22-67* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *22-67* is/are rejected.

7)☒ Claim(s) *29,40,45 and 52* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *24 March 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 09/691,310.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 45-67 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 3-10 of U.S. Patent No. 6,503,581. Although the conflicting claims are not identical, they are not patentably distinct from each other because the presently claimed product-by-process, which comprises the same materials and has the same properties, appears to be substantially identical to the product claimed in the patented invention (see MPEP 2113).

Claim Objections

2. Claims 29 and 52 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claims 29 and 52 each present the limitation "wherein the fatty acid cellulose ester film comprises a fatty acid cellulose ester having DSac of 1.5 to 2.3, and DSpr of 0.6 to 1.2. However, for the embodiment wherein DSac is 2.3, the scope of these claims is outside the scope of claims 22 and 45, respectively, because the lowest value for DSpr is 0.6, and 2.3 + 0.6 = 2.9 (claims 22 and 45 require the sum of DSac and DSpr to be 2.8 or less). This objection could be overcome by amending claims 29 and 52 so that the lower limit for DSpr is changed from "0.6" to --0.5--. See page 20, line 5-6 of the specification, which provides support for this proposed amendment.

3. Claim 40 is objected to because of the following informalities: in line 2, "of" should be corrected to --or-- (e.g. see claim 41). Appropriate correction is required.

4. Claim 45 is objected to because of the following informalities: in line 21, which currently states "casting a dope onto a belt or drum to form a", the word --film-- should be inserted after the third occurrence of "a" (e.g. see claim 22). Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 42-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 42 and 43 each recite the limitation "the stretching factor" in line 1. There is insufficient antecedent basis for this limitation in the claim. This rejection could be overcome by changing the dependency of claim 42 from claim "40" to claim --41--, and changing the dependency of claim 43 from claim "40" to claim --42-- (e.g. see claims 63-65).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 22-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,630,973 to Matsuoka et al. (Matsuoka) in view of US 5,856,468 to Shunto et al (Shunto). Matsuoka discloses an optically anisotropic cellulose ester film containing a discotic compound, wherein the film has a retardation value Rth^{550} of 60-1000 nm, most preferably 70 to 250 nm. See the abstract and column 27, lines 28-32. The cellulose

ester preferably is a cellulose ester of a lower fatty acid, such as cellulose acetate propionate (i.e. cellulose ester substituted with both acetyl groups and propionyl groups). See column 26, lines 40-47. Additionally, Matsuoka discloses preparing the cellulose ester film by casting a dope onto a drum, peeling a film of the dope from the drum, and drying the film while both sides of the film are fixed with pin-tenters. See column 59, lines 1-8. However, while Matsuoka discloses the average acetic acid content (i.e. a measure of the degree of acetyl substitution) for an embodiment wherein the cellulose ester film is cellulose acetate, Matsuoka does not disclose the sum of the degree of substitution for the embodiment wherein the cellulose ester film is cellulose acetate propionate.

Shunto discloses a cellulose acetate propionate film having a degree of acetyl substitution (DSac) and a degree of propionyl substitution (DSpr) which preferably satisfy $2.6 < DSac + DSpr \leq 3.0$, wherein the film is exemplified as having a degree of acetyl substitution of 2.38 and a degree of propionyl substitution of 0.39 (i.e. a sum of 2.77). See the abstract and column 10, lines 31-61. It would have been obvious to use a cellulose acetate propionate having an optimized degree of substitution, as taught by Shunto, as the cellulose ester in the film and method of Matsuoka because it is taught that cellulose acetate propionate having such as degree of substitution is soluble in various organic solvents and has physical properties the same or better that those of cellulose triacetate.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Pertinent Prior Art

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

JP 9-090101 discloses an optical film consisting of a fatty acid cellulose ester having an acetate group and a propionate group having a retardation Rth of 40 nm $\geq$ Rth > 0 nm.

US 5,695,594 discloses a method of producing an acylated cellulose film comprising the steps of dissolving acylated cellulose in a solvent, spreading the acylated cellulose solution on a film-forming surface, initially drying the spread solution layer on the film forming surface, removing the resultant solvent-containing film from the film forming surface, and finally drying the removed film while allowing the film to shrink in the transverse direction, wherein the final drying procedure can be carried out while conveying the film by using a pin tenter. The acylated cellulose film produced by the method has an optical isotropy of 50 nm or less.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John A. McPherson whose telephone number is (571)

272-1386. The examiner can normally be reached on Monday through Friday, 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on (571) 272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

John A. McPherson
Primary Examiner
Art Unit 1756

JAM
4/27/06